

## **REMARKS**

### **Pending Claims**

Claims 1-2, 5, 7, 10, 12-13, 15-16, 18, 21, and 23-47 are pending in the present application, with Claims 1, 18, 34, and 41 being independent. Applicant requests reconsideration of the pending claims in view of the remarks provided below.

### **Objections to the Drawings**

In the Office Action dated December 29, 2005, the Examiner objected to the drawings as allegedly not showing every feature of the invention specified in the claims, namely the features of (1) the “transponder cannot be removed from the light guide without damaging the transponder”; (2) the “alert device”; and (3) the “display device”.

#### **The Transponder Feature**

Figure 2b of the application illustrates an exemplary embodiment of the invention in which the transponder cannot be removed from the light guide without damaging the transponder. As described in the specification with reference to Figure 2b, a light guide 120 is permanently connected to a plug 150 (see page 10, lines 5-6 of the original specification). A transponder 130 is encapsulated into the interior of the plug 150 with an encapsulation compound 220. Thus, the transponder 130 is connected to the light guide 120 via the plug in an inseparable manner (see page 10, lines 10-20 of the original specification). Therefore, the transponder 130 is coupled to the light guide 120 such that it cannot be removed from the light guide 120 without damaging the transponder 130.

Accordingly, Applicants submit that Figure 2b already shows the claimed feature that the transponder cannot be removed from the light guide without damaging the transponder. Therefore, Applicants request that the Examiner withdraw this objection to the drawings.

#### **The Alert Device and the Display Device**

Regarding the alert device and the display device, Applicants have submitted concurrently herewith a request to enter amended Figure 1 to show each item in the laser device of Figure 1. In the amended Figure 1, reference numeral 180 refers to the display device and

reference numeral 185 refers to a system controller. The alert device is a component of the system controller. Applicants have amended the specification to insert the reference numerals where appropriate.

The original specification fully describes the display device and the system controller that includes the alert device (see page 5, lines 13 to 21; page 7 lines 9 to 22; page 11, line 9 to page 12, line 3; page 12, line 19 to page 13, line 24; and page 14, line 1 to page 15, line 2 of the original specification). Therefore, Applicants submit that no new matter has been added by way of the amendments to Figure 1 and to the specification. Accordingly, Applicants request that the Examiner withdraw these objections to the drawings.

*New Matter Objection*

The Examiner objected to the amendment filed February 7, 2005 under 35 U.S.C. 132(a) for allegedly introducing new matter into the disclosure. The Examiner stated that the following claimed material is not supported by the original disclosure: “transponder cannot be removed from the light guide without damaging the transponder.”

Applicants note that the amendment to which the Examiner refers was filed on September 29, 2005, not on February 7, 2005. In addition, Applicants submit that the original disclosure adequately supports the quoted language. As explained above, Figure 2b of the application illustrates an exemplary embodiment of the invention in which a light guide 120 is permanently connected to a plug 150 (see page 10, lines 5-6 of the original specification). A transponder 130 is encapsulated into the interior of the plug 150 with an encapsulation compound 220. Thus, the transponder 130 is connected to the light guide 120 via the plug in an inseparable manner (see page 10, lines 10-20 of the original specification). Therefore, the transponder 130 is coupled to the light guide 120 such that it cannot be removed from the light guide 120 without damaging the transponder 130.

Accordingly, Applicants request that the Examiner withdraw this objection.

*Claim Rejections under 35 U.S.C. § 112, first paragraph*

The Examiner rejected Claims 1, 2, 5, 7, 10, 12, 13, 15, 16, 18, 21, 23-40, and 42 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner stated that the specification allegedly does not enable the claimed invention. In particular, the Examiner alleged that the originally filed disclosure does not teach that the “transponder cannot be removed from the light guide without damaging the transponder.”

Applicants submit that the original disclosure adequately supports the quoted language. As explained above, Figure 2b of the application illustrates an exemplary embodiment of the invention in which a light guide 120 is permanently connected to a plug 150 (see page 10, lines 5-6 of the original specification). A transponder 130 is encapsulated into the interior of the plug 150 with an encapsulation compound 220. Thus, the transponder 130 is connected to the light guide 120 via the plug in an inseparable manner (see page 10, lines 10-20 of the original specification). Therefore, the transponder 130 is coupled to the light guide 120 such that it cannot be removed from the light guide 120 without damaging the transponder 130.

Accordingly, Applicants submit that the feature of the “transponder cannot be removed from the light guide without damaging the transponder” is adequately described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Therefore, Applicants respectfully request that the Examiner withdraw these claim rejections.

*Claim Rejections under 35 U.S.C. § 112, second paragraph*

The Examiner rejected Claims 17 and 30 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants submit that the Examiner’s rejection of Claim 17 is not proper. Applicants canceled Claim 17 in the Amendment and Response filed on September 29, 2005. Accordingly, Claim 17 is not pending in the application, and Applicants request that the Examiner withdraw this rejection.

With regard to Claim 30, the Examiner does not specifically identify any allegedly indefinite aspect(s) of the claim. Claim 30 depends from Claim 18 and adds the further

limitation that the light guide is an expendable light guide. In the specification, an expendable light guide is defined as a “therapeutic fiber packed in a sterile manner for use only once.” (page 6, lines 11-12 of the original specification). Applicants submit that Claim 30, as currently written, is definite. Therefore, Applicants respectfully request that the Examiner withdraw this rejection.

Claim Rejections under 35 U.S.C. 102(b)

**Independent Claim 41**

The Examiner rejected Claims 41 and 43-47 under 35 U.S.C. § 102(b) as allegedly being anticipated by each of U.S. Patent No. 5,742,718 to Harman et al. (“*Harman*”) and International Application No. PCT/US98/20204 to Pacala et al. (“*Pacala*”). Applicants respectfully traverse all of these claim rejections. Specifically, Applicants submit that neither *Harman* nor *Pacala*, either alone or in combination, teaches or suggests the feature of the transponder being configured such that it cannot delete, overwrite, or modify the stored data, as presently recited in independent Claim 41 of the pending application.

*Harman* discloses a data module 70 coupled to a strain relief boot 60 of a fiber optic system 10. (Col. 5, lines 58-64). The data module 70 comprises a smart card 77 contained within a protective housing 73. (Col. 5, lines 61-64). The smart card 77 comprises an RF interface, a control unit, and a read/write memory. (Col. 5, lines 58-61). A top wall 74 and a bottom wall 75 of the housing 73 are removably secured together with the smart card 77, containing a Mifar PCB and ASIC chip component 78, sandwiched between. (Col. 6, lines 5-9). The EEPROM memory of the ASIC chip may be programmed to store a wide variety of data, for example, a security code corresponding to one, pre-tested authenticated fiber optic delivery system product. (Col. 6, lines 59-62). Programming of the security code is accomplished using conventional encryption data storage. (Col. 6, lines 65-66).

*Harman* does not disclose configuring the transponder such that the transponder cannot delete, overwrite, or modify the stored data. To the contrary, *Harman* discloses reprogramming its memory for reuse, which would delete, overwrite, or modify the stored data. “Preferably, the attachment is such to prevent disassembly without special tools while allowing recovery of the

PCB and ASIC chip which may be re-programmed for reuse.” (Col. 6, lines 14-17 (emphasis added)).

*Pacala* discloses an encoded optical fiber coupler comprising a magnetic stripe and a transponder chip containing laser fiber and coupler information that can be transmitted to and from the magnetic stripe. (See page 16, line 24 to page 17, line 4). *Pacala* is silent on whether the laser fiber and coupler information can or cannot be reprogrammed. Thus, *Pacala* does not disclose configuring the transponder such that the transponder cannot delete, overwrite, or modify the stored data.

Accordingly, Applicants submit that neither *Harman* nor *Pacala* discloses, teaches, or suggests at least the feature of the transponder being configured such that it cannot delete, overwrite, or modify the stored data, as presently recited by independent Claim 41 of the pending application. Furthermore, Applicants submit that none of the other documents cited by the Examiner, either alone or in combination with *Harman*, *Pacala*, *Burston*, and/or each other, disclose, teach, or suggest at least that feature. Thus, Applicants submit that independent Claim 41 is allowable over the documents cited by the Examiner.

*Claim Rejections under 35 U.S.C. 103(a)*

The Examiner rejected Claims 1, 2, 5, 7, 10, 12-13, 15-16, 18, 21, 23-40, and 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Harman* in combination with *Pacala*, U.S. Patent No. 4,907,588 to *Burston* (“*Burston*”), and the allegedly admitted prior art of gluing and welding the transponder to the fiber. Applicants respectfully traverse all of these claim rejections. Specifically, none of *Harman*, *Pacala*, and *Burston* teaches or suggests at least the features of: (1) the transponder being configured such that it cannot delete, overwrite, or modify the stored data, as similarly recited in each of independent Claims 1, 18, 34, and Claim 41 of the pending application; and (2) the transponder being coupled to the light guide such that the transponder cannot be removed from the light guide without damaging the transponder, as similarly recited in each of independent Claims 1, 18, and 34, and dependent Claim 42 of the pending application.

Feature 1: *Transponder Being Configured Such that it Cannot Delete, Overwrite, or Modify the Stored Data*

**Independent Claims 1, 18, 34, and 41**

As explained above, neither *Harman* nor *Pacala* teaches or suggests the feature that the transponder is configured such that it cannot delete, overwrite, or modify the stored data. In addition, Applicants submit that *Burston* is wholly irrelevant to this feature. *Burston* is directed to a laser system with laser actuation means. The laser system has a housing containing a laser source adapted to emit a high energy parallel laser light beam along an optical axis concentric with a socket which is designed slidably to receive a laser launch system. (Abstract; Col. 1, lines 25-28). The laser launch system is arranged to receive a fiber delivery system 25 having a single optical fiber along which focused laser radiation is directed. (Abstract). The laser source is controlled in wavelength and power output by a switching arrangement actuated by an actuator which carries coded information concerning the particular optical configuration of the laser launch system and the fiber delivery system. (Abstract). Additionally or alternatively, part of the fiber delivery system which enters into the bore of the launch system may be provided with actuators arranged to operate the switching arrangement so that the laser source is controlled in operation in accordance with the particular optical configuration of the laser launch system and the fiber delivery system. (Col. 5, lines 3-11).

*Burston* does not disclose a transponder or other data storage means operable to store identity data and specific data. Furthermore, *Burston* does not disclose configuring the transponder such that the transponder cannot delete, overwrite, or modify the stored data.

Accordingly, Applicants submit that neither *Harman*, *Pacala*, nor *Burston* discloses, teaches, or suggests at least the feature of the transponder being configured such that it cannot delete, overwrite, or modify the stored data, as presently recited in independent Claims 1, 18, 34, and 41 of the pending application. Furthermore, Applicants submit that none of the other documents cited by the Examiner, either alone or in combination with *Harman*, *Pacala*, *Burston*, and/or each other, disclose, teach, or suggest at least that feature. Thus, Applicants submit that independent Claims 1, 18, 34, and 41 are allowable over the documents cited by the Examiner.

Feature 2: *Transponder Being Coupled to the Light Guide such that the Transponder Cannot be Removed from the Light Guide without Damaging the Transponder*

**Independent Claims 1, 18, and 34, and Dependent Claim 42**

The Examiner cites *Burston* as allegedly teaching “a data carrier incorporated within the material of the coupler, and thus, as [in] applicant’s device, [teaching the feature that the data carrier] must not be removable without destroying the data carrier.” The Examiner does not specifically identify which feature of *Burston* he considers to be a “data carrier” and which feature he considers to be a “coupler.” For purposes of this Request, Applicants assume that the Examiner regards the switching arrangement and/or actuator of *Burston* as a “data carrier” and the laser launch system as a “coupler.” With that assumption, Applicants agree with the Examiner that *Burston* teaches a data carrier incorporated within the material of the coupler. However, Applicants disagree that *Burston* teaches or suggests that the data carrier is coupled to the light guide [the fiber delivery system] such that the data carrier cannot be removed from the light guide without damaging the data carrier.

*Burston* teaches that different forms of the fiber delivery system may be utilized because delivery systems are preferably disposable to prevent cross-contamination of patients and to enable cost effective manufacture. (Col. 4, lines 39-46). For different forms of the fiber delivery system to be utilized, the fiber delivery system must be replaceably mounted to the coupler, which contains the data carrier. As such, the data carrier must be releasably coupled to the fiber delivery system such that the data carrier can be removed from the fiber delivery system without damaging the data carrier.

Even assuming that the Examiner regards actuators that may be provided with the part of the fiber delivery system which enters into the bore of the launch system to be “data carriers” and the part of the fiber delivery system which enters into the bore of the launch system to be a “coupler,” we still do not believe that *Burston* discloses that the data carrier is coupled to the light guide [the fiber delivery system] such that the data carrier cannot be removed from the light guide without damaging the data carrier. *Burston* is silent as to whether and how the actuators are coupled to the fiber delivery system.

Accordingly, Applicants submit that *Burston* does not disclose, teach, or suggest at least the feature of the transponder being coupled to the light guide such that the transponder cannot

be removed from the light guide without damaging the transponder, as similarly recited in each of independent Claims 1, 18, and 34 and dependent Claim 42 of the pending application. Furthermore, Applicants submit that none of the other documents cited by the Examiner, either alone or in combination with *Burston* and/or each other, disclose, teach, or suggest at least that feature. Thus, Applicants submit that independent Claims 1, 18, and 34 and dependent Claim 42 are allowable over the documents cited by the Examiner.

The Examiner also cited “admitted prior art” of gluing and welding the transponder to the fiber. Applicants respectfully traverse the Examiner’s assertion and deny that they have made any such admission.

#### Dependent Claims

Claims 2, 5, 7, 10, 12-13, and 15-16 depend either directly or indirectly from independent Claim 1; Claims 21 and 23-33 depend either directly or indirectly from independent Claim 18; Claims 35-40 depend either directly or indirectly from independent Claim 34; and Claims 42-47 depend either directly or indirectly from independent Claim 41. Accordingly, for at least the reasons discussed above with respect to independent Claims 1, 18, 34, and 41, dependent Claims 2, 5, 7, 10, 12-13, 15-16, 21, 23-33, 35-40, and 42-47 are likewise submitted to be patentable over the documents of record. The dependent claims also recite additional features that further define the claimed invention over the cited documents. Applicants submit that the cited documents do not disclose, teach, or suggest integrating any of those additional features into the presently claimed invention. Accordingly, Applicants request separate and individual consideration of each dependent claim.

Applicants have not addressed each specific rejection of the independent and dependent claims because Applicants submit that the independent claims are allowable over the documents of record, as discussed above. Applicants have not acquiesced to any such rejection and reserve the right to address the patentability of any additional claim features in the future.



**CONCLUSION**

Applicants submit the foregoing as a full and complete response to the Office Action dated December 29, 2005. Applicants submit that the application is in condition for allowance and respectfully request such action. If any issues exist that can be resolved with an Examiner's Amendment or a telephone conference, please contact Applicants' undersigned attorney at 404.572.2809.

Respectfully submitted,



William O. Isaacs, II  
Reg. No. 44,165

King & Spalding LLP  
45<sup>th</sup> Floor, 191 Peachtree Street, N.E.  
Atlanta, GA 30303  
404.572.4600



Marked Copy

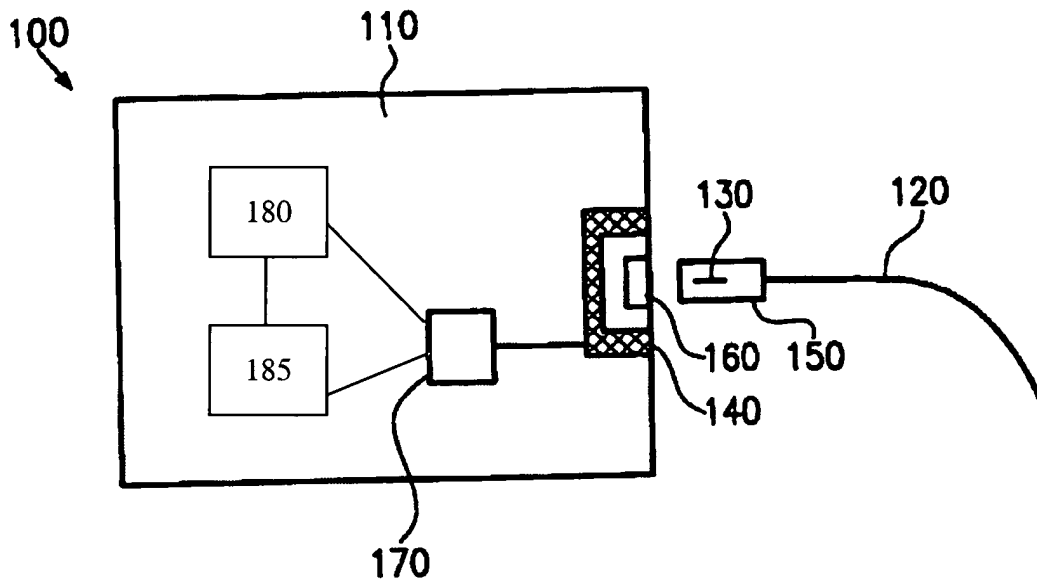


Fig. 1